

REMARKS

Applicant respectfully requests reconsideration of this application as amended. Claims 20-44 are currently pending in this application. Claim 28 has been amended, and no claims have been canceled.

Non-statutory Double Patenting

Claims 20-44 were rejected under nonstatutory obviousness-type double patenting as being unpatentable over claims 1-57 of U.S. Patent Number 6,690,536, claims 1-2 of U.S. Patent Number 6,396,474, claims 1-5 of U.S. Patent Number 5,694,151, and claims 1-2 of U.S. Patent Number 5,561,444.

If Examiner insists upon the nonstatutory double patenting rejections, Applicant, to further prosecution, will file terminal disclaimers upon an indication of otherwise allowable subject matter in the instant application.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 28-35 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. To further prosecution, Applicant has amended claim 28 to claim a machine-readable medium storing instructions. Applicant respectfully submits that claim 28, as amended, is definite and respectfully requests that the Examiner withdraw the rejection.

Claim Rejections - 35 U.S.C. §101

Claims 28-35 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. To further prosecution, Applicant has amended claim 28 to claim a machine-readable medium storing instructions. Applicant respectfully submits that claim 28, as amended, is directed to statutory subject matter. Applicant respectfully requests that the Examiner withdraw the rejection.

Claim Rejections - 35 U.S.C. §103

Claims 20-44 were rejected under 35 U.S.C. 103(a) as being obvious over Greyson, U.S. Patent 5,442,742 in view of Peters, U.S. Patent 5,157,763.

At the time the claimed invention was invented, the instant application was owned by the same assignee as the Greyson reference. The Greyson reference qualifies as prior art only under 35 U.S.C. 102(e). Thus, under 35 U.S.C. 103(c), the Greyson reference cannot be used in a 35 U.S.C. 103(a) rejection. The Peters reference does not teach or suggest the claimed invention. Accordingly, claims 20-44 are patentable over Peters. Applicant respectfully requests that the Examiner withdraw the rejection.

Claim Rejections - 35 U.S.C. §103

Claims 20-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Peters, U.S. Patent 5,157,763 in view of Alpert, "A Technique for Improving the Interactivity of Direct Manipulation", IBM Technical Disclosure Bulletin.

Peters discloses a system for moving data from one window to another window. After the user selects data to move, a box is displayed around the data in the source window. The user drags the box to another window and positions it in the other window. Then user then makes a selection from a menu as to what action to carry out.

Alpert discloses a "pause preview" system allowing a user to preview the results of a copying procedure before committing to the procedure. The user selects text and drags the cursor. Where the cursor is moved, an insertion point is displayed. If the user leaves the cursor in the same place for a period of time, the system displays the text as it would appear if the user commits to the procedure.

However, Alpert also states that displaying the text as the cursor moves would be computationally prohibitive and would result in a confusing, unstable delay. Alpert therefore expressly teaches away from a combination with Peters.

Claims 20, 28, 36, and 44 claim moving a text object following a visible symbol from a source location of a first window to a destination location of a second window while the button of a control device is in a second position. MPEP 2143.01 states that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Previewing after the user has paused the mouse is a principle of operation of the Alpert system. Combining Alpert with Peters would change the principle of operation of Alpert, since previewing would cease to follow a pause. Accordingly, the combination is not sufficient to render claims 20, 28, 36, and 44 *prima facie* obvious.

Claims 21, 29, and 37 claim deemphasizing selected text and emphasizing the text object while the text object is moving from the source location to the destination location. Examiner points to Figures 1 and 2 of Alpert as teaching this limitation. However, Alpert merely removes the highlight from the text when the user pauses long enough to preview the copy. Assuming, *arguendo*, that highlighting by Alpert is emphasizing, then Alpert merely stops emphasizing the text, rather than deemphasizing the text as claimed. Thus, Alpert does not teach or suggest the claimed limitation. Accordingly, claims 21, 29, and 37 are patentable over Peters in view of Alpert.

Claims 23, 31, and 39 claim visually zooming at least a portion of the selected text from the first bounding rectangle of the source location to the second bounding rectangle of the destination location when the button of the control device is in the first position. Examiner points to Figure 3 of Peters as teaching this limitation. However, Figure 3 of Peters occurs in the context of moving the box from one window to another.

According to Examiner's earlier interpretation of Peters, the movement of outline 9 in Figure 3 occurs when the button of the control device is in the second position. The movement of outline 9 cannot occur both while the button of the control device is in both the first and the second position. Accordingly, Peters must fail to teach or suggest either the limitations of claims 20, 28, 36 or the limitations of claims 23, 31, and 39. In either case, claims 23, 31, and 39 are patentable over Peters in view of Alpert.

Therefore, the combination cannot render obvious Applicant's invention as claimed in claim(s) 20-44, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

Applicant respectfully submits that in view of the amendments and arguments set forth herein, the applicable rejections have been overcome and the claims are in condition for allowance.

Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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James C. Scheller, Jr.
Attorney for Applicant
Reg. No.: 31,195
Jim_Scheller@bstz.com

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300